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Paper No. 8

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**COPY MAILED**

**OCT 12 2001**

**OFFICE OF PETITIONS**

In re Application of :  
Reid et al. :  
Application No. 09/739,933 : DECISION REFUSING STATUS  
Filed: 18 December, 2000 : UNDER 37 CFR 1.47(a)  
Attorney Docket No. 07306-021001 :

This is in response to the renewed petition under 37 CFR 1.47(a)<sup>1</sup>  
filed on 2 October, 2001.

The petition is again **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of  
this decision to reply, correcting the below-noted deficiencies.  
Any reply should be entitled "Request for Reconsideration of  
Petition Under 37 CFR 1.47(a)," and should only address the  
deficiencies noted below, except that the reply may include an  
oath or declaration executed by the non-signing inventor.

**FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.**

Extensions of time may be obtained in accordance with 37 CFR  
1.136(a).

The above-identified application was filed on 18 December, 2000,  
naming James S. Reid and James H. Fallon as joint inventors, with

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<sup>1</sup>A grantable petition under 37 CFR 1.47(a) requires:

(1) proof that the non-signing inventor cannot be reached or refuses to  
sign the oath or declaration after having been presented with the application papers  
(specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C.  
§§ 115 and 116;

(3) the petition fee; and

(4) a statement of the last known address of the non-signing inventor.

a declaration signed by joint inventor Fallon. The petition under 37 CFR 1.47(a) filed on 18 December, 2000, was dismissed in a decision mailed on 7 May, 2001. The present renewed petition is accompanied by, *inter alia*, a petition for a three (3)-month extension of the time for reply to the decision mailed on 7 May, 2001.

Petitioners again assert that the application papers were presented to joint inventor Reid, but that Reid has refused to execute the declaration.

A grantable petition under 37 CFR 1.47(a) requires:

(1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C.

§§ 115 and 116;

(3) the petition fee; and

(4) a statement of the last known address of the non-signing inventor.

The renewed petition lacks item (1).

In regards to item (1), the petition still does not present a sufficient showing of proof that a copy of the application papers were sent or given to the non-signing inventor for review.<sup>2</sup> As stated in the decision mailed on 7 May, 2001, petitioners may provide the requisite showing of proof by submitting a copy of the cover letters transmitting the application papers to the non-signing inventor or details given in an affidavit or declaration of facts by a person having first-hand knowledge of the details. The declaration of petitioner's registered patent attorney, Michael Reed, however, states only that the attorney is informed and believes that a copy of the application has been provided to the non-signing inventor, and that the attorney personally sent a copy of the declaration and power of attorney to the non-signing inventor. Thus, petitioners have not provided an affidavit or declaration of facts from a person having first-hand knowledge that a copy of the application (specification, including claims, drawings, if any, and the declaration) was sent or given to the non-signing inventor. Additionally, as stated previously, petitioners may provide the requisite proof by submitting a copy

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<sup>2</sup>MPEP 409.03(e).

of the cover letter transmitting the application papers to the non-signing inventor.

Additionally, petitioners must show proof that the non-signing inventor refuses to sign the declaration after being sent or given the application.<sup>3</sup> If there is a written refusal, petitioners should submit a copy of that refusal with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of facts.

Further correspondence with respect to this matter should be addressed as follows:

By mail:           Assistant Commissioner for Patents  
                    Box DAC  
                    Washington, D.C. 20231

By FAX:           (703) 308-6916  
                    Attn: Office of Petitions

By hand:           Crystal Plaza Four, Suite 3C23  
                    2201 S. Clark Place  
                    Arlington, VA

Telephone inquiries related to this decision should be directed to the undersigned at 703-308-6918.



Douglas I. Wood  
Petitions Attorney  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy

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<sup>3</sup>Id.